

## REMARKS

The Office Action dated September 7, 2005 has been received and reviewed by the applicant. Claims 1-36, 38-44 and 46-51 remain in the application. Claims 1-3, 15-23, 25-29, 32-36, 38, 39, 41-44 and 46-51 stand rejected, and claims 14, 24, 30, 31, and 40 stand objected to.

Applicant agrees with the Examiner's Double Patenting analysis of claims 17 and 37. Accordingly, Claim 37 is hereby cancelled and those claims that originally depended from claim 37 (with the exception of now-independent Claim 40) have been amended to depend directly or indirectly from Claim 17.

Claim 25 has been amended to depend from original claim 24, wherein there is antecedent basis for the phrase "the rotation position."

Claims 1-3, 7-11, 15, 17, 19-20, 26, 28, 38, 39, 42-44, 46, 49, 51 stand rejected under 35 USC 102(e) as anticipated by Butterfield et al. (US 6,685,297). The rejection is respectfully traversed.

Independent Claims 1, 17, 46 and 49 require that the second pattern of dots consists of dots that are discrete and spaced from the dots of the first pattern. In fact, the present invention relies on the dots of the second pattern being distinguishable from the first pattern of dots in order to measure the relative errors. This is opposed to the teaching of Butterfield et al., who rely on the fact that at least some of the dots of the second pattern overlap at least some of the dots of the first pattern. Accordingly, Butterfield et al. teaches away from the claimed invention. "[A] reference must have been considered in its entirety, for disclosures which taught away from the invention as well as disclosures which directed one skilled in the art towards the claimed subject matter." *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 227 USPQ 657,666 (Fed. Cir., 1985).

Claims 29, 32-39, 41-51 stand rejected under 35 USC 102(b) as being anticipated by Underwood et al. (US 6,109,722). The rejection is respectfully traversed.

Claims 38 and 39 now depend upon Claim 17, and are allowable therewith as discussed above. Independent Claim 29 has been amended to more clearly define that the dots are spaced one from another so as to be distinguishable. As in the case of Butterfield et al., the reference to Underwood et al. relies on the fact that at least some of the dots of the second pattern overlap at least some of the dots of the first pattern. Also as in the case of Butterfield et al., Underwood et al. teaches away from the claimed invention.

Claims 4-5, 12-13, 16, 18, 21-23, 27, 36, 41 stand rejected under 35 USC 103(a) as being unpatentable over Butterfield et al. (US 6,685,297) in view of Underwood et al. (US 6,109,722). The rejection is respectively traversed.

As discussed above, the primary reference to Butterfield et al. fails to disclose that the second pattern of dots consists of dots that are discrete and spaced from the dots of the first pattern. The Underwood et al. also fails to disclose this feature. Assuming arguendo that the references might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination. "Each element of a claim is material." *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 USPQ 657,666 (Fed. Cir., 1985)

The Examiner has indicated the presence of allowable subject matter in Claims 14, 24, 25, 30-31 and 40. Claims 14, 24, 30-31 and 40 have been rewritten in independent form. Claim 25 has been amended to depend from allowable claim 24 and, as indicated above, to overcome the rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. Accordingly, these claims are believed, with appreciation, to be considered to be allowable by the Examiner.

The present invention offers ease-of-use benefits of nozzle bank alignment relative to the visual techniques of the prior art. Hundreds of alignment compensations can be performed with little operator intervention. Prior art methods generally rely on carriage-based sensors, which typically have poor resolving capability and hence require simple patterns to dissect components of alignment error. This requires substantial printing time, and can consume considerable amounts of media. By printing and later digitizing (via a scanner, digital camera, etc.) a pattern of separated, discrete dots in a small area, a vast

number of nozzle banks can be aligned, accounting for a vast number of possible components to the original misalignment.

For the reasons set forth above, it is believed that the application is in condition for allowance. Accordingly, reconsideration and favorable action are respectfully requested.

Respectfully submitted,



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